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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,687	10/22/2003	Hugh Stephen Laver	CO/21-21222/A/CPA 2/CONT	6151
324	7590	10/26/2005	EXAMINER SZEKELY, PETER A	
CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			ART UNIT 1714	PAPER NUMBER
DATE MAILED: 10/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/690,687	LAVER ET AL.	
	Examiner	Art Unit	
	Peter Szekely	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-9,11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-9,11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/017,082.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/26/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1-4 and 6-9, 11 and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. The indefinite word "type" renders all claims indefinite. Claims 1-4, 6-9, 11 and 14-16 are hybrid claims. The claims are directed to a heat curable powder, that is an uncured composition, which makes the subsequent cure and curing conditions irrelevant. Claim 6 is indefinite because further additives can comprise everything under the sun and it is broader than the list of additives in the specification, which would make one of ordinary skill in the art unsure trying to figure out what materials of the unmentioned variety is an additive and which one is not. Claim 9 contains improper Markush language, since "and/or" is treated as it were "and". Claim 16 depends from itself.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4, 6-9, 11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ertl 4,745,192, Malik et al. 5,679,733 or Valet et al. 5,753,729, in view of Dubs 5,175,312 or Nesvadba et al. 5,516,920, further in view of Nozaki et al. 5,310,848, Daly et al. 5,708,039 or Kaplan et al. 5,847,057.

7. All limitations in applicants' claims had been before the Board of Patent Appeals & Interferences, which has affirmed the examiner's rejection. Therefore the examiner shall basically repeat the rejection in the Examiner's Answer. Ertl discloses epoxides resins, acrylic resins with hardeners and powder coatings in column 7, lines 10-63 and benzofuran-2-one in column 8, line 8. Malik et al. teach epoxy resins in column 13, lines 35 and 61 and claims 9-10, benzofuran-2-one in column 16, lines 44-45 and powder coatings in column 17, lines 48-51 and claim 10. Valet et al. recite applicants polymers from column 8, line 50, through column 9, line 39 and from column 21, line 63, through column 22, line 9, powder coatings in column 12, lines 45-48 and column 13, lines 10-12 and benzofuranes in column 30, lines 55-67. Dubs et al. reveal

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3-phenylbezofuran-2-ones in the Abstract and columns 1 and 2 and applicants' polymers in column 5, lines 28-36. Nesvadba et al. divulge applicants' specific 3-arylbenzofuran-2-one as a preferred one. See, from column 14, line 12, to column 15, line 55 and column 12, line 23, to column 24, line 11. For polymers see column 27, lines 15-30. The tertiary references are cited only to show that the use of a gas oven or carbon dioxide medium for the curing of powder coatings are standard techniques and because of this all attempts to stabilize powder coatings would have included trying to neutralize the effects of nitrogen oxides. It would have been obvious to one having ordinary skill in the art; at the time the invention was made, to use the benzofuran-2-ones of the secondary references in the compositions of the primary references, because they are trying to stabilize the same polymers.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
10/21/05